UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/761,506	DOHERTY ET AL.
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 January 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-37</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-37</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>18 February 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claims 1-37 have been examined.

Claim Objections

Claim 36 is objected to because of the following informalities: In the second-last

line of claim 36 (the twenty-eighth line), "after the identifier means" is ungrammatical,

apparently a phrase copied from another claim with means rather than steps.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. In the thirty-third and thirty-fourth lines of

claim 1 (the last two lines of the claim), "the set of advertisements stored separate from

another" is not described in the specification, if the limitation be read as stating that

each advertisement is stored separately from the other advertisements. (The

advertisements are described as being stored separately from the multimedia

presentation.)

Claims 32-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. In the twenty-fifth and twenty-sixth lines of

claim 32 (the last two lines of the claim), "the set of advertisements stored separate

from another" is not described in the specification, if the limitation be read as stating that

each advertisement is stored separately from the other advertisements. (The

advertisements are described as being stored separately from the multimedia

presentation.)

Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. In the thirty-third and thirty-fourth lines of claim 35,

"the set of advertisements stored separate from another" is not described in the

specification, if the limitation be read as stating that each advertisement is stored

separately from the other advertisements. (The advertisements are described as being

stored separately from the multimedia presentation.)

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. In the thirty-seventh line of claim 37, "the set of

advertisements stored separate from another" is not described in the specification, if the

limitation be read as stating that each advertisement is stored separately from the other

advertisements. (The advertisements are described as being stored separately from

the multimedia presentation.)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Claim 1 recites, "the set of advertisements stored

separate from each other," in the thirty-third and thirty-fourth lines of the claim (the last

two lines). This is ambiguous, because it could be read as reciting either (1) that the set

of advertisements is stored separately from the multimedia presentation, or (2) that

each advertisement in the set is stored separately from the other advertisements in the

set.

Claims 32-34 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Claim 32 recites, "the set of advertisements stored separate from each other," in the twenty-fifth and twenty-sixth lines of the claim (the last two lines). This is ambiguous, because it could be read as reciting either (1) that the set of advertisements is stored separately from the multimedia presentation, or (2) that each advertisement in the set is stored separately from the other advertisements in the set.

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 35 recites, "the set of advertisements stored separate from each other," in the thirty-third and thirty-fourth lines of the claim. This is ambiguous, because it could be read as reciting either (1) that the set of advertisements is stored separately from the multimedia presentation, or (2) that each advertisement in the set is stored separately from the other advertisements in the set.

Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 37 recites, "the set of advertisements stored separate from each other," in the thirty-seventh line of the claim. This is ambiguous, because it could be read as reciting either (1) that the set of advertisements is stored separately from the multimedia presentation, or (2) that each advertisement in the set is stored separately from the other advertisements in the set.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 1-31

Claims 1, 2, 4, 8, 9, 10, 11, 12, and 15 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S.

Patent 6,308,206) and Markus et al. (U.S. Patent 6,490,601). As per claim 1, Gever

discloses an Internet advertising system comprising: a multimedia presentation

comprising at least one component selected from a group consisting of computer

generated animation and full-motion video, a given item within the selected component

of the multimedia presentation represented by (presumably) an embedded placeholder,

the embedded placeholder programmed to follow a series of actions of the given item

within the multimedia presentation (column 2, line 5, through column 3, line 5); a set of

advertisements corresponding to the embedded placeholder, each advertisement being

indexed by at least one demographic indicator (column 1, lines 52-61; column 2, line 5,

through column 3, line 5; column 8, lines 3-10); identifier means for identifying at least

one demographic characteristic of a user, wherein the at least one demographic

characteristic of the user corresponds to one of the at least one demographic indicator

(inherent from column 2, lines 36-52); selector means for selecting a relevant

advertisement from the set of advertisements, the selector means configured to receive

the at least one demographic characteristic of the user from the identifier means, and

the selector means including a comparison of the user's at least one demographic

characteristic with the at least one demographic characteristic of each advertisement to

select the relevant advertisement for the user (inherent from column 2, line 26, through

column 3, line 5, and column 8, lines 3-10; providing an appropriate animation

sequence or other Web page component based on the geographic location of a visitor is

held to imply means for making necessary comparisons, etc.); inserter means for

inserting the relevant advertisement into the embedded placeholder of the multimedia

presentation, the inserter means configured to receive the relevant advertisement from

the selector means so as to create an advertisement programmed to dynamically follow

the series of actions of the given item integrated within the multimedia presentation and

targeted to the user's demographic characteristics, and configured to insert the relevant

advertisement after identifying the at least one demographic characteristic (inherent

from column 2, line 14 through column 3, line 5; and column 8, lines 3-10); and delivery

means for delivering the multimedia presentation to the user (column 15, line 49, through column 16, line 14). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

Gever does not expressly disclose that each of the advertisements are stored separate from the multimedia presentation, but it is well known for advertisements to be stored separate from a website, as taught, for example, by Markus (column 1, line 66, through column 2, line 37); this also teaches delivering to the user the ad created by the inserter means from the website and the set of ads stored separately. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the advertisements to be stored separately, for the obvious advantage of enabling data from advertisers to be integrated into Web sites stored elsewhere.

As per claim 2, Gever discloses a hyperlink in the advertisement or other multimedia presentation (column 6, lines 13-15; Figure 4; column 8, lines 25-35; see also claim 6).

As per claim 4, Gever discloses that the multimedia presentation is an animation (Abstract; and repeated references to animation throughout the Gever patent).

As per claim 8, neither Gever nor Singh expressly discloses that the multimedia presentation includes at least two embedded placeholders, but Gever discloses creating one *or more* individualized Web page components (column 2, lines 9-11), and it is held to be within the scope of a person of ordinary skill in the art to duplicate known parts for multiple effects (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)). Furthermore, Markus teaches that many Web pages contain links to dozens of separate remote Internet resources (column 1, line 66, through column 2, line 37). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the multimedia presentation include at least two embedded placeholders, for the obvious advantage of presenting several advertisements, other Web page components, or parts thereof.

As per claim 9, Gever discloses multiple advertisements (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10). Neither Gever nor Singh expressly discloses that there are multiple sets of advertisements, each set corresponding to one of the at least two embedded placeholders, but it is held to be within the scope of a person of ordinary skill in the art to duplicate known parts for

multiple effects (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th

Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)).

Furthermore, Markus teaches that many Web pages contain links to dozens of separate

remote Internet resources (column 1, line 66, through column 2, line 37). Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention for there to be multiple sets of advertisements, each set

corresponding to one of the at least two embedded placeholders, for the obvious

advantage of presenting multiple ads, at different points in a web site, and/or at different

times during a multimedia presentation.

As per claim 10, Gever discloses that the identifier means can include cookies

generated by an Internet browser of the user (column 15, line 60, through column 16,

line 8, the browser being held to follow from the cookies and other Internet-related

procedure, as in column 1, lines 11-21).

As per claim 11, Gever discloses that the identifier means can include a survey

completed by the user (column 15, line 49, through column 16, line 8).

As per claim 12, Gever does not expressly disclose that the inserter means is a

computer program, but does disclose that the inserter means involves manipulating

Web pages (column 2, line 14 through column 3, line 5; and column 8, lines 3-10), and

discloses prior art programs for preparing Web pages (column 1). Hence, it would have

been obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention for the inserter means to be (or comprise) a computer program, for

the obvious advantage of inserting relevant advertisements automatically according to

demographics and other factors, without having to employ a human being to monitor

Web traffic and make insertions by hand.

As per claim 15, Gever discloses that the components of a Web page (which, as

above, may be multimedia presentations, or parts of a multimedia presentation) may not

be situated on a server, but only referenced by URL address (which implies being

stored on a second server elsewhere) (column 15, lines 3-16).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever,

Singh, and Markus as applied to claim 2 above, and further in view of LeMole et al.

(U.S. Patent 6,009,410). Gever does not expressly disclose that the hyperlink in the

advertisement is a hyperlink to an advertiser's website (although "LINK1 =

'WWW.BUYLATER.COM'" in Figure 4 is highly suggestive). However, it is well known

for advertisements to contain hyperlinks to an advertiser's website, as taught, for

example, by LeMole (Abstract). Hence, it would have been obvious to one of ordinary

skill in the art of electronic commerce at the time of applicant's invention for the

hyperlink in the advertisement to be a hyperlink to an advertiser's website, for the

obvious advantage of encouraging users to browse catalogs, etc., and make purchases

at the advertiser's website.

Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gever, Singh, and Markus as applied to claim 4 above, and further in view of the

anonymous article, "Macromedia Flash Animation Now Native in RealSystem 5.0." As

per claim 5, Gever does not disclose that the animation is created using Flash, but

Flash is a well-known system for creating animations, as taught by "Macromedia Flash

Animation Now Native in RealSystem 5.0" (note that the paragraph beginning

"Advertisers using Flash" specifically teaching using Flash to create advertisements for

the Web, complete with animation). Hence, it would have been obvious to one of

ordinary skill in the art of electronic commerce at the time of applicant's invention for the

animation to be created using Flash, for the obvious advantage of readily creating

animations viewable by many client systems.

As per claim 7, Gever discloses selecting from a plurality of pre-existing

animation sequences (column 2, lines 9-20), an embedded placeholder presumably

being added, as per Singh, to enable the desired pre-existing or modified animations to

be displayed as desired.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever,

Singh, Markus, and the anonymous article, "Macromedia Flash Animation Now Native in

RealSystem 5.0," as applied to claim 5 above, and optionally further in view of Borella et

al. (U.S. Patent 6,182,125). Gever does not expressly disclose that the animation is an

original presentation, but it could be taken as inherent that some animations are original

presentations (not all animations could be copies of each other). Furthermore, the

article, "Macromedia Flash Animation Now Native in RealSystem 5.0," discloses

creating animations. But if, arguendo, this does not suffice, Borella teaches web pages

including original content, including animation (column 4, lines 41-46). Hence, it would

have been obvious to one of ordinary skill in the art of electronic commerce at the time

of applicant's invention for the Flash animation to be an original presentation, for the

obvious advantage of enabling the presenter to provide an animation according to his

own desires and tastes, and to avoid having to pay royalties to someone else for use of

a copied presentation.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever,

Singh, and Markus as applied to claim 12 above, and further in view of Simpson (U.S.

Patent 6,453,300). Gever does not expressly disclose that the computer program is

Generator, but Macromedia Generator is well known, as taught by the Simpson patent,

which specifically teaches using Macromedia Generator in conjunction with Flash to

personalize presentations (column 12, lines 3-16). Hence, it would have been obvious

to one of ordinary skill in the art of electronic commerce at the time of applicant's

invention to use Generator, for the obvious advantage of accomplishing the creation of

Flash or similar animations using a standard, widely available package for that purpose.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever,

Singh, and Markus as applied to claim 12 above, and further in view of Chen et al. (U.S.

Patent 5,822,524). Gever does not expressly disclose that the computer program and

the multimedia presentation are stored on the same server, but it is well known for

various programs, data files, etc., to be stored on the same server, as taught, for

example, by Chen (column 1, lines 21-64). Hence, it would have been obvious to one

of ordinary skill in the art of electronic commerce at the time of applicant's invention to

have the computer program and the multimedia presentation both stored on the first

server, for the obvious advantage of ready accessibility.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever,

Singh, and Markus as applied to claim 1 above, and further in view of the Microsoft

Press Computer Dictionary and Jones ("Working on Site"). As per claim 16, Gever

discloses delivery over a connection between a server storing the Web page component

(which can be a multimedia presentation, as above) and discloses a viewer/user to

whom pictures are transmitted, implying a computer operated by the user (column 9,

lines 46-55). Gever does not expressly disclose that the connection is an Internet

connection, but does refer to network connections and a Web page component. The

Internet is a well-known network, as taught, for example, by the Microsoft Press

Computer Dictionary (second definition of "Internet" on page 258, and subsequent

entries relating to the Internet on pages 259-261) and it is well known that the World

Wide Web is part of the Internet, as taught, for example, by Jones (Abstract, and

paragraph beginning, "Marketers should be familiar"). Hence, it would have been

obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention for the network connection to be an Internet connection, for the

obvious advantage of connecting to the enormous number of people who access the

Internet.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever,

Singh, Markus, the Microsoft Press Computer Dictionary and Jones ("Working on Site")

as applied to claim 16 above, and further in view of official notice. Gever does not

disclose a syndication network, but official notice is taken that syndication networks (as

defined by the instant specification, page 10, lines 19-21) are well known, e.g.,

advertisers who supply banner ads to one or more Websites for publication. Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention for the system to comprise a syndication network, for the

obvious advantage of readily placing advertisements or other desired components on

multiple Web sites.

Claims 18, 19, 21, 24, and 26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Gever, Singh, Markus, the Microsoft Press Computer Dictionary,

Jones ("Working on Site"), and official notice as applied to claim 17 above, and further

in view of Kauffman et al. (U.S. Patent Application Publication 2002/0073084). As per

claim 18, Kauffman teaches a syndication network collecting a multimedia presentation

and a selected advertisement, and delivering the multimedia presentation containing the

selected advertisement to the user's computer (paragraphs 7-10, 18-20, and 24;

Figures 1 and 3). Hence, it would have been obvious to one of ordinary skill in the art of

electronic commerce at the time of applicant's invention to have a syndication network

do this, for the stated advantage of incorporating advertising to target particular end

users.

As per claim 19, Kauffman teaches that the syndication network collects the

multimedia presentation and the selected advertisement separate from one another,

and a server in the syndication network inserts the selected advertisement into the

multimedia presentation (paragraphs 7-10, 18-20, and 24; Figures 1 and 3). Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention to have the syndication network do this, for the stated

advantage of incorporating advertising to target particular end users.

As per claim 20, Neither Gever nor Kauffman discloses a syndication network
that collects the multimedia presentation having the selected advertisement inserted
therein previous to entering the syndication network, but official notice is taken that it is
well known to collect presentations or programs having advertisements already inserted
therein (an example would be TV stations receiving and broadcasting national programs
with nationwide advertisements already inserted by the networks). Hence, it would
have been obvious to one of ordinary skill in the art of electronic commerce at the time
of applicant's invention to have the syndication network collect the multimedia
presentation having the selected advertisement inserted therein previous to entering the
syndication network, for the obvious advantage of distributing presentations with ads
already included, the ads being either likely to be of interest to many viewers in general,
or likely to be of interest to many viewers of the multimedia presentation.

As per claim 21, Kauffman teaches that the syndication network collects
information relating to the identifier means from the user's computer (or other device),
and delivers the identifier information to a rule server (selection means) which selects
appropriate advertisements (see especially paragraph 19; also Figure 1). Hence, it
would have been obvious to one of ordinary skill in the art of electronic commerce at the
time of applicant's invention to have the syndication network do this, for the stated
advantage of incorporating advertising to target particular end users.

As per claim 24, Gever does not disclose that the system comprises a media
buyer providing at least a portion of the set of advertisements, but official notice is taken
that media buyers brokering advertising space, etc., are well known. Hence, it would

have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a media buyer to provide at least a portion of the set of advertisements, for the obvious advantage of running advertisements provided by persons and organizations which provide many advertisements.

Kauffman teaches identifier information from the syndication network being delivered to a rule server/selector means (paragraph 19; Figure 1), as in claim 21, and delivering the identifier information to the media buyer is not a significant distinction, inasmuch as the media buyer places relevant advertisements in appropriate places.

As per claim 25, Kauffman does not teach that the identifier information is delivered from the syndication network to the media buyer and from the media buyer to the selector means, but official notice is taken that it is well known to forward information from one party to another. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to deliver the identifier information from the syndication network to the media buyer and from the media buyer to the selector means, for the obvious advantage of making the identifier information available to the various interested parties.

As per claim 26, Kauffman does not teach that the identifier information is delivered from the syndication network to the media buyer, and the identifier information is also delivered from the syndication network to the selector means, but official notice is taken that it is well known to deliver information to multiple concerned parties (for example, CC'ing emails). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the identifier

information is delivered from the syndication network to the media buyer and also to the selector means, for the obvious advantage of making the identifier information available to the various interested parties.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 1 above, and further in view of McCarthy et al. (U.S. Patent 6,904,408). Gever does not disclose that the system comprises a media buyer providing at least a portion of the set of advertisements, but media buyers brokering advertising space, etc., are well known, as taught, for example, by McCarthy (column 16, lines 15-24). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a media buyer to provide at least a portion of the set of advertisements, for the obvious advantage of running advertisements provided by persons and organizations which provide many advertisements.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, Markus, and McCarthy as applied to claim 22 above, and further in view of official notice. Gever does not disclose that the media buyer receives information relating to the identifier means from the user's computer, but official notice is taken that it is well known for advertisers to receive information relating to identifier means from a user's computer. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the media buyer to receive information relating to identifier means from a user's computer, for such obvious advantages as determining what advertisements to present to a user (based on

demographics, etc.), billing for presentation of relevant advertisements to users in relevant categories, and enabling the advertiser/media buyer to contact the user if the user expresses interest, orders goods or services, etc.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 1 above, and further in view of Krishan et al. (U.S. Patent 6,442,529). As per claim 27, Gever does not disclose means for assessing an advertisement charge to the sponsor of the selected advertisement delivered in the multimedia presentation, but it is well known to charge the sponsors of advertisements for running or displaying their ads, as taught, for example, by Krishan (column 1, lines 46-54). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means for assessing an advertisement charge to the sponsor of the selected advertisement delivered in the multimedia presentation, for the stated advantage of making money from displaying the selected advertisement.

Claims 28, 29, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, Markus, and Krishan as applied to claim 27 above, and further in view of official notice. As per claim 28, Gever does not disclose that the sponsor's advertising charge is paid to an owner of the multimedia presentation, but official notice is taken that it is well known for advertising charges to be paid to the owners of programs in which the ads appear. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the sponsor's advertising charge to be paid to an owner of the multimedia

presentation, for the obvious advantage of making money for displaying ads in

multimedia presentations, or, from another perspective, for the obvious advantage of

persuading the owners of multimedia presentations to display one's ads.

As per claim 29, Gever does not disclose that the sponsor's advertisement

charge is apportioned to a group comprising an owner of the multimedia presentation

and an owner of a media buyer providing the selected advertisement, but official notice

is taken that it is well known to make payments (commissions) to media buyers; for

payments to owners of multimedia presentations, see rejection of claim 28 above.

Hence, it would have been obvious to one of ordinary skill in the art of electronic

commerce at the time of applicant's invention for the sponsor's advertisement charge to

be apportioned to a group comprising an owner of the multimedia presentation and an

owner of a media buyer providing the selected advertisement, for the reasons set forth

above in rejecting claim 28, and for the obvious advantage of compensating a media

buyer for its services in placing ads.

As per claim 30, Gever does not disclose that the sponsor's advertisement

charge is apportioned to a group comprising an owner of the multimedia presentation,

an owner of a media buyer providing the selected advertisement, and an owner of the

delivery means for providing the multimedia presentation to the user, but official notice

is taken that it is well known to make payments to owners of delivery means (websites,

ISP's, cable TV companies, etc.); for payments to owners of multimedia presentations

and media buyers, see rejection of claims 28 and 29 above. Hence, it would have been

obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention for the sponsor's advertisement charge to be apportioned to a

group comprising an owner of the multimedia presentation, an owner of a media buyer

providing the selected advertisement, and an owner of the delivery means for providing

the multimedia presentation to the user, for the reasons set forth above in rejecting

claims 28 and 29, and for the obvious advantage of compensating the owner of delivery

means for his services in allowing an ad to run, or from the other perspective, of

profiting from running ads.

As per claim 31, Gever does not disclose that the delivery means is a syndication

network, but official notice is taken that syndication networks (as defined by the instant

specification, page 10, lines 19-21) are well known, e.g., advertisers who supply banner

ads to one or more Websites for publication. Hence, it would have been obvious to one

of ordinary skill in the art of electronic commerce at the time of applicant's invention for

the delivery means to be a syndication network, for the obvious advantage of placing

advertisements or other desired components on multiple Web sites.

It is noted that claims 1-31 use "means for" language. Nonetheless, they are not

treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35

U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that

effect. 35 U.S.C. 112, sixth paragraph states:

> An element in a claim for a combination may be expressed as a
> means or step for performing a specified function without the recital of
> structure, material or acts in support thereof, and such claim shall be
> construed to cover the corresponding structure, material, or acts described
> in the specification and equivalents thereof.

Claims 32-34

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et

al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206) and Markus et al.

(U.S. Patent 6,490,601). Gever discloses an Internet advertising system comprising: a

multimedia presentation comprising at least one component selected from a group

consisting of computer generated animation and full-motion video, a given item within

the selected component of the multimedia presentation represented by (presumably) an

embedded placeholder, the embedded placeholder programmed to follow a series of

actions of the given item within the multimedia presentation (column 2, line 5, through

column 3, line 5); a set of advertisements corresponding to the embedded placeholder

(column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10);

identifier means for identifying a user (inherent from column 2, lines 36-59); selector

means for selecting a relevant advertisement from the set of advertisements, wherein

the selector means select the relevant advertisement subsequent to the identification of

the user by the identifier means (column 2, line 26, through column 3, line 5, and

column 8, lines 3-10); inserter means for inserting the relevant advertisement into the

embedded placeholder of the multimedia presentation, the inserter means configured to

receive the relevant advertisement from the selector means so as to create a seamless

advertisement programmed to dynamically follow the series of actions of the given item

integrated within the multimedia presentation and targeted to the user's demographic

characteristics, and configured to insert the relevant advertisement after identifying the

at least one demographic characteristic (inherent from column 2, line 14 through column

3, line 5; and column 8, lines 3-10); and delivery means for delivering the multimedia

presentation to the user (column 15, line 49, through column 16, line 14). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for such alternative pictures or animations as a background which changes with the time or season (column 3, lines 1-5). Even if Gever's invention could somehow be implemented as described in Gever's patent without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements, animations, etc., were to be presented in accordance with the site visitor's demographic characteristics and other relevant data.

Gever does not expressly disclose that each of the advertisements are stored separate from the multimedia presentation, but it is well known for advertisements to be stored separate from a website, as taught, for example, by Markus (column 1, line 66, through column 2, line 37); this also teaches delivering to the user the ad created by the inserter means from the website and the set of ads stored separately. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the advertisements to be stored separately, for the obvious advantage of enabling data from advertisers to be integrated into Web sites stored elsewhere.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever, Singh, and Markus as applied to claim 32 above, and further in view of Sawyer (U.S.

Patent 6,084,628). Gever does not disclose that the selector randomly selects the

advertisement, but Sawyer teaches randomly selecting advertisements (column 4, lines

57-65). Hence, it would have been obvious to one of ordinary skill in the art of

electronic commerce at the time of applicant's invention for the selector to randomly

select the advertisement, for the stated advantage of ensuring that each advertisement

reflected in a profile is shown an appropriate number of times.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever,

Singh, and Markus as applied to claim 32 above, and further in view of Kauffman et al.

(U.S. Patent Application Publication 2002/0073084). Gever does not expressly disclose

that the seamless advertisement is dynamically contained in the multimedia

presentation, but Kauffman teaches this (paragraphs 17-20). Hence, it would have

been obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention for seamless advertisement to be dynamically contained in the

multimedia presentation, for the obvious advantage of presenting dynamic

advertisements to viewers.

It is noted that claims 32-34 use "means for" language. Nonetheless, they are

not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35

U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that

effect. 35 U.S.C. 112, sixth paragraph states:

> An element in a claim for a combination may be expressed as a
> means or step for performing a specified function without the recital of
> structure, material or acts in support thereof, and such claim shall be

construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claim 35

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206), Kauffman (U.S. Patent Application Publication 2002/0073084), Markus et al. (U.S. Patent 6,490,601), the anonymous article, "Macromedia Flash Animation Now Native in RealSystem 5.0," Simpson (U.S. Patent 6,453,300), McCarthy et al. (U.S. Patent 6,904,408), LeMole et al. (U.S. Patent 6,009,410), the anonymous article "RedEye Recruitment: RedEye Recruitment Push to Meet Growing Industry Demand for Accountable Online Advertising Tracking," Krishan et al. (U.S. Patent 6,442,529), the anonymous article "Sony Goes to the Net via Visa," and optionally in view of Borella et al. (U.S. Patent 6,182,125). Gever discloses an Internet advertising system comprising: a multimedia presentation comprising at least one component selected from a group consisting of computer generated animation and full-motion video, a given item within the selected component of the multimedia presentation represented by (presumably) an embedded placeholder, the embedded placeholder programmed to follow a series of actions of the given item within the multimedia presentation (column 2, line 5, through column 3, line 5); a set of advertisements corresponding to the embedded placeholder (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8, lines 3-10); cookies generated by an Internet browser of a user for identifying at least one demographic characteristic of the user (column 15, line 60, through column 16, line 8, the browser

being held to follow from the cookies and other Internet-related procedure, as in column

1, lines 11-21); selector means for selecting a relevant advertisement from the set of

advertisements, the selector means configured to receive at least one demographic

characteristic of the user (column 2, line 26, through column 3, line 5, and column 8,

lines 3-10). Gever does not expressly disclose the selector means comparing the

user's cookies with the demographic indicators of advertisements, but given the

disclosure of cookies, and of selecting advertisements or other Web page components

based on demographic characteristics, this is obvious. Gever discloses inserting the

relevant advertisement into the embedded placeholder of the multimedia presentation,

creating an advertisement programmed to dynamically follow the series of actions of the

given item integrated within the multimedia presentation and targeted to the user's

demographic characteristics, after identifying at lest one demographic characteristic of

the user (inherent from column 2, line 14 through column 3, line 5; and column 8, lines

3-10). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place

for such alternative pictures or animations as a background which changes with the time

or season (column 3, lines 1-5). Even if Gever's invention could somehow be

implemented as described in Gever's patent without anything qualifying as an

embedded placeholder, the use of embedded placeholders is well known, as taught by

Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary

skill in the art of electronic commerce at the time of applicant's invention to use an

embedded placeholder as recited, for the obvious advantage of readily presenting

whatever advertisements, animations, etc., were to be presented in accordance with the

site visitor's demographic characteristics and other relevant data.

Gever does not expressly disclose that the multimedia presentation is a Flash

animation multimedia presentation, but Flash is a well-known system for creating

animations, as taught by "Macromedia Flash Animation Now Native in RealSystem 5.0"

(note that the paragraph beginning "Advertisers using Flash" specifically teaching using

Flash to create advertisements for the Web, complete with animation). Hence, it would

have been obvious to one of ordinary skill in the art of electronic commerce at the time

of applicant's invention for the animation to be created using Flash, for the obvious

advantage of readily creating animations viewable by many client systems.

Gever does not disclose a Macromedia Generator computer program for

inserting the relevant advertisement into the embedded placeholder, but Macromedia

Generator is well known, as taught by the Simpson patent, which specifically teaches

using Macromedia Generator in conjunction with Flash to personalize presentations by

inserting particular data (column 12, lines 3-16). Hence, it would have been obvious to

one of ordinary skill in the art of electronic commerce at the time of applicant's invention

to use Macromedia Generator, for the obvious advantage of accomplishing the creation

of Flash or similar animations using a standard, widely available package for that

purpose.

Gever does not disclose that the system comprises a media buyer providing at

least a portion of the set of advertisements, but media buyers brokering advertising

space, etc., are well known, as taught, for example, by McCarthy (column 16, lines 15-

24). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a media buyer to provide at least a portion of the set of advertisements, for the obvious advantage of running advertisements provided by persons and organizations which provide many advertisements.

Kauffman teaches identifier information from the syndication network being delivered to a rule server/selector means (paragraph 19; Figure 1), and delivering the identifier information to the media buyer is not a significant distinction, inasmuch as the media buyer places relevant advertisements in appropriate places. Kauffman does not expressly teach that the identifier information is delivered from the syndication network to the media buyer, and the identifier information is also delivered from the syndication network to the selector means, but "RedEye Recruitment" teaches using cookies to enable advertisers to identify users (two paragraphs beginning from, "Says Paul Cook, founder"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the identifier information to be delivered from the syndication network to the media buyer as well as to the selector means, for the stated advantage of enabling advertisers to identify and target specific viewers, and personalize advertisements to individuals' needs.

Gever does not disclose a syndication network, but Kauffman teaches a syndication network for delivering to a computer operated by the user a multimedia advertising presentation (paragraphs 7-10, 18-20, and 24; Figures 1 and 3). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention to have a syndication network do this, for the stated

advantage of incorporating advertising to target particular end users.

Gever discloses a hyperlink in the advertisement or other multimedia

presentation (column 6, lines 13-15; Figure 4; column 8, lines 25-35; see also claim 6).

Gever does not expressly disclose that the hyperlink in the advertisement takes the user

to an advertiser's website (although "LINK1 = 'WWW.BUYLATER.COM'" in Figure 4 is

highly suggestive). However, it is well known for advertisements to contain hyperlinks

to an advertiser's website, as taught, for example, by LeMole (Abstract). Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention for the hyperlink in the advertisement to be a hyperlink to

an advertiser's website, for the obvious advantage of encouraging users to browse

catalogs, etc., and make purchases at the advertiser's website.

Gever does not disclose assessing a fee to the user for delivery of the

multimedia presentation, but it is well known to charge fees to users for viewing

desirable content, fees being apportioned to one or more of the content owner, the

owner of a delivery system, and/or the owner of a media buyer, as taught, for example,

by "Sony Goes to the Net Via Visa" (especially the first paragraph). Hence, it would

have been obvious to one of ordinary skill in the art of electronic commerce at the time

of applicant's invention to assess such a fee, for the obvious advantages of profiting

from providing the services of providing and delivering content, and attracting

advertisements by paying commissions to buyers.

Gever does not disclose assessing an advertisement charge to the sponsor of

the selected advertisement delivered in the multimedia presentation, but it is well known

to charge the sponsors of advertisements for running or displaying their ads, as taught,

for example, by Krishan, Krishan further teaching payment to the owner of delivery

means (column 1, lines 46-54). Hence, it would have been obvious to one of ordinary

skill in the art of electronic commerce at the time of applicant's invention to include

means for assessing an advertisement charge to the sponsor of the selected

advertisement delivered in the multimedia presentation, and apportioning payment, for

the stated advantage of making money from displaying the selected advertisement.

Gever does not expressly disclose that the animation is an original presentation,

but it could be taken as inherent that some animations are original presentations (not all

animations could be copies of each other). Furthermore, the article, "Macromedia Flash

Animation Now Native in RealSystem 5.0," discloses creating animations. But if,

arguendo, this does not suffice, Borella teaches web pages including original content,

including animation (column 4, lines 41-46). Hence, it would have been obvious to one

of ordinary skill in the art of electronic commerce at the time of applicant's invention for

the Flash animation to be an original presentation, for the obvious advantage of

enabling the presenter to provide an animation according to his own desires and tastes,

and to avoid having to pay royalties to someone else for use of a copied presentation.

Gever does not expressly disclose that there are multiple sets of advertisements,

each set corresponding to one of the at least two embedded placeholders, but it is held

to be within the scope of a person of ordinary skill in the art to duplicate known parts for

multiple effects (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th

Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960)).

Furthermore, Markus teaches that many Web pages contain links to dozens of separate

remote Internet resources (column 1, line 66, through column 2, line 37). Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention for there to be multiple sets of advertisements, each set

corresponding to one of the at least two embedded placeholders, for the obvious

advantage of presenting multiple ads, at different points in a web site, and/or at different

times during a multimedia presentation.

It is noted that claim 35 uses "means for" language ("selector means").

Gever does not expressly disclose that each of the advertisements are stored

separate from the multimedia presentation, but it is well known for advertisements to be

stored separate from a website, as taught, for example, by Markus (column 1, line 66,

through column 2, line 37); this also teaches delivering to the user the ad created by the

inserter means from the website and the set of ads stored separately. Hence, it would

have been obvious to one of ordinary skill in the art of electronic commerce at the time

of applicant's invention for the advertisements to be stored separately, for the obvious

advantage of enabling data from advertisers to be integrated into Web sites stored

elsewhere.

It is noted that claim 35 uses "means for" language ("selector means").

Nonetheless, it is not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant

wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit

statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a
means or step for performing a specified function without the recital of
structure, material or acts in support thereof, and such claim shall be
construed to cover the corresponding structure, material, or acts described
in the specification and equivalents thereof.

Claim 36

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et

al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206) and Markus et al.

(U.S. Patent 6,490,601). Gever discloses an Internet advertising method comprising:

providing a multimedia presentation comprising at least one component selected from a

group consisting of computer generated animation and full-motion video, a given item

within the selected component of the multimedia presentation represented by

(presumably) an embedded placeholder, the embedded placeholder programmed to

follow a series of actions of the given item within the multimedia presentation (column 2,

line 5, through column 3, line 5); providing a set of advertisements corresponding to the

embedded placeholder, each advertisement being indexed by at least one demographic

indicator (column 1, lines 52-61; column 2, line 5, through column 3, line 5; column 8,

lines 3-10); identifying at least one demographic characteristic of a user(inherent from

column 2, lines 36-52); selecting a relevant advertisement from the set of

advertisements, the advertisement selection including a comparison of the user's at

least one demographic characteristic with at least one demographic characteristic of

each advertisement to select the relevant advertisement for the user (inherent from

column 2, line 26, through column 3, line 5, and column 8, lines 3-10; providing an

appropriate animation sequence or other Web page component based on the

geographic location of a visitor is held to imply means for making necessary

comparisons, etc.); inserting the relevant advertisement into the embedded placeholder

of the multimedia presentation, creating an advertisement programmed to dynamically

follow the series of actions of the given item integrated within the multimedia

presentation and targeted to the user's demographic characteristics (inherent from

column 2, line 14 through column 3, line 5; and column 8, lines 3-10); and delivering to

the user a multimedia presentation including an advertisement, after identifying the

user, including demographic information (column 15, line 49, through column 16, line

14). Arguably, Gever's disclosure implies an embedded placeholder, to hold a place for

such alternative pictures or animations as a background which changes with the time or

season (column 3, lines 1-5). Even if Gever's invention could somehow be

implemented as described in Gever's patent without anything qualifying as an

embedded placeholder, the use of embedded placeholders is well known, as taught by

Singh (column 3, lines 50-63). Hence, it would have been obvious to one of ordinary

skill in the art of electronic commerce at the time of applicant's invention to use an

embedded placeholder as recited, for the obvious advantage of readily presenting

whatever advertisements, animations, etc., were to be presented in accordance with the

site visitor's demographic characteristics and other relevant data.

Gever does not expressly disclose that each of the advertisements are stored

separate from the multimedia presentation, but it is well known for advertisements to be

stored separate from a website, as taught, for example, by Markus (column 1, line 66,

through column 2, line 37); this also teaches delivering to the user the ad created by the inserter means from the website and the set of ads stored separately. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the advertisements to be stored separately, for the obvious advantage of enabling data from advertisers to be integrated into Web sites stored elsewhere.

Claim 37

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable Gever et al. (U.S. Patent 6,313,835) in view of Singh (U.S. Patent 6,308,206), Kauffman (U.S. Patent Application Publication 2002/0073084), Markus et al. (U.S. Patent 6,490,601), the anonymous article, "Macromedia Flash Animation Now Native in RealSystem 5.0," Simpson (U.S. Patent 6,453,300), McCarthy et al. (U.S. Patent 6,904,408), LeMole et al. (U.S. Patent 6,009,410), the anonymous article "RedEye Recruitment: RedEye Recruitment Push to Meet Growing Industry Demand for Accountable Online Advertising Tracking," Krishan et al. (U.S. Patent 6,442,529), the anonymous article "Sony Goes to the Net via Visa," and optionally in view of Borella et al. (U.S. Patent 6,182,125). Claim 37 is closely parallel to claim 35, and rejected on essentially the same grounds.

Response to Arguments

Applicant's arguments filed January 20, 2006 have been fully considered but they are not persuasive. First of all, it is noted that Applicant traversed some of Examiner's

takings of official notice, to which Examiner has responded by making other prior art of

record, and using these in statements of rejection. Traversals of official notice can be

entirely proper, but the Manual of Patent Examination Procedure (2144.03(C)) states:

> C. If Applicant Challenges a Factual Assertion as Not Properly
>
> Officially Noticed or not Properly Based Upon Common Knowledge, the
>
> Examiner Must Support the Finding with Adequate Evidence.
>
> To adequately traverse such a finding, an applicant must specifically point
>
> out the supposed errors in the examiner's action, which would include stating
>
> why the noticed fact is not considered to be common knowledge or well-known in
>
> the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ
>
> at 241 ("[I]n the absence of any demand by appellant for the examiner to produce
>
> authority for his statement, we will not consider this contention."). A general
>
> allegation that the claims define a patentable invention without reference to the
>
> examiner's assertion of official notice would be inadequate.

It may be questioned whether Applicant's traversals are proper, and in some

cases it is not clear precisely what Applicant was traversing. Examiner is obliged to

respond to even an entirely proper traversal of official notice only by documenting the

fact(s) of which official notice was taken, not by finding a single reference which

discloses all limitations of the claim(s) at issue. Whether there was proper motivation to

combine the different references or known facts, making the claimed invention obvious

to one of ordinary skill in the relevant art at the time of the applicant's invention, is a

different issue.

Applicant has traversed Examiner's taking of official notice in claim 3. In

response, Examiner has relied upon LeMole et al. (U.S. Patent 6,009,410) to establish

that it was known for advertisements (with animation, etc.) to contain hyperlinks to the

advertisers' websites. Yacoby et al. (U.S. Patent 6,516,311) teaches this as well

(column 9, lines 13-25).

Applicant has traversed Examiner's taking of official notice in claims 5-7. In

response, Examiner has relied upon the article, "Macromedia Flash Animation Now

Native in RealSystem 5.0" to establish that Flash is a well-known system for animations.

In claim 6, Examiner further used Borella et al. (U.S. Patent 6,182,125) to establish, if

necessary, that it is known for animations to be original.

Applicant has traversed Examiner's taking of official notice in claim 13. In

response, Examiner has relied upon Simpson (U.S. Patent 6,453,300) to establish that

Macromedia Generator was well known.

Applicant has traversed Examiner's taking of official notice in 14. In response,

Examiner has relied upon Chen et al. (U.S. Patent 5,822,524) to establish that it was

well known to store various programs and datafiles on a server.

Applicant has traversed Examiner's taking of official notice in claims 16 and 17.

In response, Examiner has relied upon the Microsoft Press computer Dictionary to

establish that the Internet was a well-known network, and on Jones ("Working on Site")

to establish that the World Wide Web is part of the Internet.

Applicant has traversed Examiner's taking of official notice in claim 18 and its

dependents, but in fact, no further taking of official notice was made in rejecting claim

18.

Applicant has traversed Examiner's taking of official notice in rejecting claim 22

and its dependent claim 23. In response, Examiner has relied upon McCarthy et al.

(U.S. Patent 6,904,408) to establish that media buyers for advertising were well known.

Applicant has traversed Examiner's taking of official notice in claim 27 and its

dependents. In response, Examiner has relied upon Krishan et al. (U.S. Patent

6,442,529) to establish that is was known to charge the sponsors of advertisements for

running or displaying their ads.

Applicant has traversed Examiner's taking of official notice in claim 33. In

response, Examiner has relied upon Sawyer (U.S. Patent 6,084,628) to establish that it

was known to select advertisements randomly.

Applicant also traversed Examiner's taking of official notice in claim 34, but

Examiner in fact rejected claim 34 (in the previous Office Action) based on three cited

U.S. patent documents, without use of official notice.

Applicant has traversed Examiner's taking of official notice in claim 35 and

parallel claim 37. In response, Examiner has relied upon the anonymous article,

"Macromedia Flash Animation Now Native in RealSystem 5.0," Simpson (U.S. Patent

6,453,300), McCarthy et al. (U.S. Patent 6,904,408), LeMole et al. (U.S. Patent

6,009,410), the anonymous article "RedEye Recruitment: RedEye Recruitment Push to

Meet Growing Industry Demand for Accountable Online Advertising Tracking," Krishan

et al. (U.S. Patent 6,442,529), the anonymous article "Sony Goes to the Net via Visa,"

and optionally Borella et al. (U.S. Patent 6,182,125) to establish various facts of which

official notice was taken. Some of these facts are the same as some noted above in

regard to other claims; additionally, "RedEye Recruitment" was used to establish that it

was known to use cookies to enable advertisers to identify users; "Sony Goes to the Net

via Visa" was used to establish that it was known to charge fees to users for viewing

desirable content, fees being apportioned to one or more of the content owner, the

owner of a delivery system, and/or the owner of a media buyer.

The common knowledge or well-known in the art statements in the previous

office action which Applicant did not traverse are taken to be admitted prior art, because

Applicant did not traverse Examiner's taking of official notice.

Applicant argues, regarding claim 1 and the other independent claims, that

Applicant's invention differs from Gever, even in combination with Singh, in that in

Applicant's claims, advertisements are stored separately from a multimedia

presentation, and added "on the fly." Examiner replies that this does indeed distinguish

over Gever, but that Markus (made of record in response to Applicant's amendments)

teaches an "ad server" model where pages are composite pages, requiring images, text,

etc., to be pulled from several different remote internet resources, integrating banner

ads (for example) into composite web pages. Markus teaches this, furthermore, as

something already known at the time of his application, over which his invention

represents an improvement. Examiner concludes, therefore, that this element of

Applicant's claims would have been obvious to one of ordinary skill in the art at the time

of Applicant's invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Yacoby et al. (U.S. Patent 6,516,311) disclose a method for

linking on the Internet with an advertising feature. Gardner et al. (U.S. Patent

7,003,734) discloses a method and system for creating and displaying images. Beyda

et al. (U.S. Patent Application Publication 2002/0082914) disclose a hybrid network

based advertising system and method.

Giman ("National Web Ad Network for Alternative Weeklies") discloses a

syndication service by which advertisers can purchse banner ads on many websites in a

single transaction. Quinton ("U S West Dex to Sell Targeted Internet Ads; Directory Will

Match Web Sites with Local Sellers") discloses a syndication service by which

advertisers buy banner ads on multiple we sites. The anonymous article, "GoTo.com's

Online Marketplace Reaches More Than 10,000 Advertisers, 80,000 Network Affiliate

Sites, an Estimated 10 Million Unique Users and a Top Relevance Ranking in NPD

Survey," discloses a search syndication service with 80,000 affiliate sites.

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-

272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

acting supervisor, Robert Pond, can be reached at 571-272-6760. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-

6762.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

March 22, 2006